

Appl. No.: 10/055,521  
Art Unit: 1712; Docket No.: B01-13  
Reply to Office Action of July 23, 2004

### REMARKS

Claims 1-31 and new claims 32-35 appear in this application for the Examiner's review and consideration.

Claim 1 has been amended to recite that the core is a solid, non-wound core and that the solid core contains the plasticized polyurethane. Claims 15-16 have been amended to better clarify the claimed invention.

New claims 32-35 have been added and are believed to be allowable because they recite elements not found in the references, either alone or in combination, cited in the Office Action.

No new matter has been added by these amendments and additions.

### Rejection Over Yokota '157

Claims 1-5, 16, 18, 19, 23-25, and 29-31 were rejected under 35 U.S.C. § 102(e) as being anticipated by or, in the alternative under 35 U.S.C. § 103(a) as being obvious over Yokota '157.

For claims to be rejected under 35 U.S.C. § 102(e), each and every element as set forth in the claims of the present invention must be found, either expressively or inherently, in a single prior art reference. Further, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits that Yokota does not disclose all of the elements of independent claim 1 of the present invention, in particular a *core* containing a base rubber and a plasticized polyurethane composition. Moreover, not only does Yokota not disclose or even suggest such a core, Yokota, in fact, teaches that the *cover* (and not the core) can be polyurethane and could include specific plasticizers.

For at least the above reasons, independent claim 1 is believed to be in condition for allowance. Moreover, the dependent claims are believed to be patentable by virtue of their dependence from the independent claims. As such, Applicant respectfully requests that the rejections under 35 U.S.C. §§ 102(e) and 103(a) be reconsidered and withdrawn.

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#### **Rejection Over Dusbiber '061**

Claims 1-5, 16, 18, 19, 21-25, 29, and 31 were rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative under 35 U.S.C. § 103(a) as being obvious over Dusbiber '061.

Like Yokota above, Applicant respectfully submits that Dusbiber does not disclose all of the elements of independent claim 1 of the present invention, in particular a core containing a base rubber *and* a plasticized polyurethane composition. Moreover, not only does Dusbiber not disclose or even suggest such a core, Dusbiber teaches that if the core is polyurethane, it is as a sole core material and *not a blend* with a base rubber.

For at least the above reasons, independent claim 1 is believed to be in condition for allowance. Moreover, the dependent claims are believed to be patentable by virtue of their dependence from the independent claims. As such, Applicant respectfully requests that the rejections under 35 U.S.C. §§ 102(b) and 103(a) be reconsidered and withdrawn.

#### **Rejection Over Kato '663**

Claims 1-5, 16-18, 23-25, and 29 were rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative under 35 U.S.C. § 103(a) as being obvious over Kato '663.

Like Yokota and Dusbiber above, Applicant respectfully submits that Kato does not disclose all of the elements of independent claim 1 of the present invention, in particular a *non-wound*, solid core containing a base rubber and a plasticized polyurethane composition. Moreover, not only does Kato not disclose or even suggest such a core, Kato, in fact, teaches away by requiring that the golf ball be thread-wound.

For at least the above reasons, independent claim 1 is believed to be in condition for allowance. Moreover, the dependent claims are believed to be patentable by virtue of their dependence from the independent claims. As such, Applicant respectfully requests that the rejections under 35 U.S.C. §§ 102(b) and 103(a) be reconsidered and withdrawn.

#### **Rejection Over Murphy '253 in view of Yokota or Dusbiber**

Claims 1-8, 12, 23-25, 29, and 30 were rejected under 35 U.S.C. § 103(a) as being obvious over Murphy '253 in view of Yokota or Dusbiber.

Applicant respectfully submits that Murphy does not cure the deficiencies of Yokota and Dusbiber. Murphy, even in combination with the other two references, fails to disclose or even

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suggest all of the elements of independent claim 1 of the present invention, in particular a core (golf ball or otherwise) containing a base rubber *and* a plasticized polyurethane composition.

For at least the above reasons, independent claim 1 is believed to be in condition for allowance. Moreover, the dependent claims are believed to be patentable by virtue of their dependence from the independent claims. As such, Applicant respectfully requests that the rejections under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

#### **Rejection Over Sullivan '618**

Claims 1, 16, 18-22, and 29-31 were rejected under 35 U.S.C. § 102(e) as being anticipated by or, in the alternative under 35 U.S.C. § 103(a) as being obvious over Sullivan '618.

Applicant respectfully submits that Sullivan does not disclose all of the elements of independent claim 1 of the present invention, in particular a *core* containing a base rubber *and* a plasticized polyurethane composition. Moreover, not only does Sullivan not disclose or even suggest such a core, Sullivan, in fact, teaches that the *cover* (and not the core) can be polyurethane and could include specific plasticizers.

For at least the above reasons, independent claim 1 is believed to be in condition for allowance. Moreover, the dependent claims are believed to be patentable by virtue of their dependence from the independent claims. As such, Applicant respectfully requests that the rejections under 35 U.S.C. §§ 102(e) and 103(a) be reconsidered and withdrawn.

#### **Rejection Over Sullivan in view of Yokota or Dusbiber**

Claims 1-8, 12, 23-25, 29, and 30 were rejected under 35 U.S.C. § 103(a) as being obvious over Murphy '253 in view of Yokota or Dusbiber.

Applicant respectfully submits that Sullivan does not cure the deficiencies of Yokota and Dusbiber. Sullivan, even in combination with the other two references, fails to disclose or even suggest all of the elements of independent claim 1 of the present invention, in particular a core containing a base rubber *and* a plasticized polyurethane composition.

For at least the above reasons, independent claim 1 is believed to be in condition for allowance. Moreover, the dependent claims are believed to be patentable by virtue of their dependence from the independent claims. As such, Applicant respectfully requests that the rejections under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

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### Rejection Over Maruko '573

Claims 1-5, 15-25, and 291 were rejected under 35 U.S.C. § 102(e) as being anticipated by or, in the alternative under 35 U.S.C. § 103(a) as being obvious over Maruko '573.

Applicant respectfully submits that Maruko does not disclose all of the elements of independent claim 1 of the present invention, in particular a *core* containing a base rubber *and* a plasticized polyurethane composition. Moreover, not only does Maruko not disclose or even suggest such a core, Maruko, in fact, only teaches that one of the *middle layers* (and not the core) can be a urethane and could allegedly include a plasticizer.

For at least the above reasons, independent claim 1 is believed to be in condition for allowance. Moreover, the dependent claims are believed to be patentable by virtue of their dependence from the independent claims. As such, Applicant respectfully requests that the rejections under 35 U.S.C. §§ 102(e) and 103(a) be reconsidered and withdrawn.

### CONCLUSION

Based on the remarks set forth above, Applicant believes that all of the rejections have been overcome and the claims of the subject application are in condition for allowance. Should the Examiner have any further concerns or believe that a discussion with the Applicant's attorney would further the prosecution of this application, the Examiner is encouraged to call the attorney at the number below.

A fee of \$72 is believed to be due for this submission for the 4 new claims. Should any other required fees be due, however, please charge them to Acushnet Company Deposit Account No. 502309.

Respectfully submitted,



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